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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/356,692 | 07/20/1999 | KATSUMI AZUSAWA | 35.C7695CONT | 8167 |

7590 03/18/2003

FITZPATRICK CELLA HARPER & SCINTO
277 PARK AVENUE
NEW YORK, NY 10172

EXAMINER

TRAN, NHAN T

| ART UNIT | PAPER NUMBER |
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2615

DATE MAILED: 03/18/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/356,692

Applicant(s)

AZUSAWA ET AL.

Examiner

Nhan T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/380,336.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 12, 13, 23 - 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 - 10 & 12 of U.S. Patent No. 6,014,169.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 12, 13, 23 - 26 are encompassed by patent claims 7-10 & 12.

Regarding claims 12 & 23, it is noted that both claims 12 and 23 of the instant application correspond to claim 7 of the U.S. Patent No. 6,014,169. The correspondence is:

an image pickup apparatus (i.e., video camera);

image pickup means for converting an optical image pickup plane into an electrical image signal (see col. 9, lines 19 - 21), and outputting the electrical image signal (see col. 9, line 27 for "output from said image pickup means");

detection means for detecting a shake of said apparatus (see col. 9, lines 22 - 23 for "vibration detection means"), and for outputting a detection output (see col. 9, line 25 for "detected by vibration detection means" which presents the linking of "outputting a detection output" in the instant application);

correcting means/compensating means for correcting/compensating a movement of the image caused by the shake on the basis of the detection output of said detection means (see col. 9, lines 24 - 25 for "compensation means for compensating said vibration detected vibration detection means"); and

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control means for disabling said correcting means in the case that said image pickup means is not converting the optical image into the electrical image signal and not outputting the electrical image signal (see col. 9, lines 30 – 37).

It is noted that, in the claimed invention of U.S. Patent No. '169, the limitation(s) of "control means for discriminating whether said recording/reproducing means performs a reproduction operation of the recorded signal, and for controlling said compensating means according to the discrimination so as to automatically inhibit a compensation operation of said compensating means during the reproduction operation regardless of a detection output of said vibration detecting means" is/are narrower than the instant claimed invention in the application.

Claim 7 of the '169 patent explicitly claims the video camera apparatus operates in either recording mode to record signal output from the image pickup means on a recording medium, or reproducing mode to reproduce a recorded signal from said recording medium. In claim 7 of the '169 patent, when the camera operates in recording mode, the camera does not operate in the reproducing mode, or vice versa. The control means in claim 7 of the '169 patent automatically inhibits the compensating means in the reproducing mode, meaning that the compensating means is inhibited or disabled when the video camera not outputting the electrical image signal.

Regarding claim 13, the instant claim corresponds to claim 9 of the U.S. Patent No. '169.

Regarding claim 24, the instant claim corresponds to claim 8 of the U.S. Patent No. '169.

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Regarding claim 25, the instant claim corresponds to claims 9 and 10 of the U.S. Patent No. '169.

Regarding claim 26, the instant claim corresponds to claim 12 of the U.S. Patent No. '169.

Therefore, each limitation of claims 12, 13, 23 - 26 in the instant application corresponds to patent claims 7 - 10 & 12 of the U.S. Patent No. 6,014,169. In view of this, it is noted that allowing the claims 12, 13, 23 - 26 would result an unjustified or improper timewise extension of the "right to exclude" granted by a patent. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

3. Claims 14 - 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 - 12 of U.S. Patent No. 6,014,169 in view of Sekine et al (US 5,561,498).

Regarding claims 14 & 15, although the claimed invention of the U.S. Patent No. '169 does not contain the limitation of "monitor means for displaying the electrical image signal output from said image pickup means" and "monitor means comprises an electronic viewfinder", such monitor means (e.g., an electronic viewfinder) would have been obvious to be included in the claimed video camera apparatus in the U.S. Patent No. '169. In fact, the monitor means (e.g.,

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electronic viewfinder or EVF) is suggested by Sekine et al for displaying images so that the user can view taken images (see fig. 1, col. 5, lines 18-33).

Therefore, it would have been obvious to one of ordinary skill in the art to include a monitor means in the video camera for user to view the taken images.

Regarding claim 16, the instant claim is established as an obvious function of camera being turned off, in which no image is output to the electronic viewfinder, the control means must move the correcting means to a position where a decentering amount with respect to the optical axis becomes zero (i.e., initial position), and thereafter, further movement of the correcting means must be disabled in order for the camera system to be turned off properly.

Therefore, it would have been obvious to those skilled in the art to recognize that the camera being turned off properly in a well-known, conventional way.

Regarding claim 17, the instant claim recites the same claimed invention of claim 7 of the U.S. Patent No. '169 except for the limitation of "displaying means for converting the image signal output from image pickup means into an image, and for displaying said image;" However, such displaying means (e.g., electronic viewfinder EVF) would have been obvious to be included in the claimed video camera apparatus in the U.S. Patent No. 6,014,169. In fact, the displaying means is suggested by Sekine et al for displaying images so that the user can view taken images (see fig. 1, col. 5, lines 18-33).

Therefore, it would have been obvious to one of ordinary skill in the art to include a displaying means in the video camera for user to view the taken images.

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Regarding claim 18, the instant claim corresponds to claim 8 of the U.S. Patent No. '169.

Regarding claim 19, the instant claim corresponds to claims 9 and 10 of the U.S. Patent No. '169.

Regarding claim 20, the instant claim corresponds to claim 11 of the U.S. Patent No. '169.

Regarding claim 21, the instant claim corresponds to claim 12 of the U.S. Patent No. '169.

Regarding claim 22, the instant claim corresponds to claim 12 of the U.S. Patent No. '169.

In view of the above, since the subject matters recited in the claims 14 - 22 of the instant application were fully disclosed in and covered by the claims 7 - 12 of the U.S. Patent No. 6,014,169, allowing the claims 14 - 22 would result in an unjustified or improper timewise extension of the "right to exclude" granted by a patent. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhan T. Tran whose telephone number is (703) 605-4246. The examiner can normally be reached on Monday - Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

NT.
March 10, 2003


NGOC YEN VU
PRIMARY EXAMINER